

REMARKS

Claims 3-12 are pending and stand rejected. By this Response, Applicant respectfully traverses the rejection of claims 3-12 and requests reconsideration of the subject patent application in view of the following remarks.

In the Office Action, claims 3-12 were rejected under 35 U.S.C. § 103(a) over Hutchison (U.S. Patent No. 6,449,476) in view of Hoffman (U.S. Patent No. 6,622,017) and further in view of Iizuka (U.S. Patent No. 5,933,595). This rejection is respectfully traversed in view of the following remarks and in addition to Applicant's prior submissions.

Each of the independent claims 3, 8 and 9 require loading a bug fix patch into a volatile memory and then creating a backup of the bug fix patch in the same volatile memory. Accordingly, each of the claims of the present application require two copies of the bug fix patch in the same volatile memory.

The Office Action acknowledges that Hutchison, Hoffman and the combination thereof do not show or suggest "copying the software features into the volatile memory to create a backup software to be stored in the read only memory." (Office Action at p. 3.) To cure the deficiencies of Hutchison and Hoffman, the Office Action cites Iizuka.

Applicant respectfully submits that, even taken collectively, the above cited references Hutchison, Hoffman, and Iizuka do not disclose each and every element of the claimed invention. In the Background of the Invention, Iizuka discloses a nonvolatile memory card, which stores a debugged control program. After the nonvolatile memory card is externally connected to the microcomputer, the debugged control program is read from the nonvolatile memory card and stored in the internal volatile RAM. The patch is then written from the volatile RAM into the flash ROM. Nowhere does Iizuka teach creating a backup copy of the patch in the volatile RAM, in addition to the copy read from the non-volatile memory card.

When lizuka is combined with Hutchison and Hoffman as suggested in the Office Action, the combination thereof provides for only a single copy of the debugged control program stored in the internal volatile RAM. Therefore, the combination of the above cited references does not disclose creating a backup patch in the volatile memory by copying the patch already loaded in the volatile memory as recited in the claimed invention. Consequently, even if the above references can be combined as suggested in the Office Action, the combination does not disclose the claimed invention.

Moreover, Applicant respectfully submits that there is no motivation in the cited references that they be combined to arrive at the claimed invention. In the final Office Action, the Examiner stated that, when combining lizuka with Hutchison and Hoffman to establish the prima facie obviousness case,

the Examiner only relies on lizuka for the teaching of transferring or copying data software from a RAM to a ROM for fixing a portion of the ROM regardless of where the ROM and RAM located.¹ (Office Action at p. 6.)

In response to the above proposition, Applicant refers to Section 2141.02 of the Manual of Patent Examining Procedure (M.P.E.P.), which states that:

Prior art must be considered in its entirety, including disclosures that teach away from the claims.

Accordingly, one must consider a prior art reference as a whole and cannot omit the portion in the prior art reference that would lead away from the claimed invention.

In this case, although the portion of lizuka cited by the Office Action shows that data on an external RAM card can be transferred to a computer's internal RAM, and subsequently transferred to internal ROM, the remainder of lizuka explicitly teaches away from the cited portion. As Applicant previously submitted, lizuka teaches **directly** transferring the data from the external RAM to the internal ROM, bypassing the internal

¹ The Examiner's statement here appears to contradict to his reasoning for citing lizuka to be combined with the other two references—lizuka teaches a way to copy software features into the volatile memory to create a backup software to be stored in the read only memory. (Office Action at p. 3) Clarification is requested.

RAM. In other words, lizuka teaches that *no* patch at all is to be stored to internal RAM, much less a backup patch, because the patch is transferred directly from the external RAM to the ROM. Such teaching of lizuka is in direct contrast to the explicit limitations of independent claims 3, 8 and 9 which require "copying the patch into the volatile memory to create a backup patch."

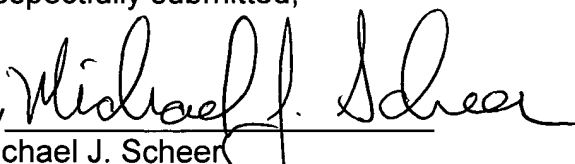
Therefore, Applicant respectfully submits that when the cited prior art is considered in its entirety, there is no suggestion or motivation in the cited references to combine them in order to arrive at the claimed invention. Accordingly, a *prima facie* case of obviousness has not been made. (M.P.E.P. § 2143.) If anything, the cited art teaches away from a motivation to combine.

In view of the above, the claimed invention is not obvious over the cited references. Accordingly, withdrawal of the rejections of claims 3-12 is thus respectfully requested.

Applicant has shown that pending claims 3-12 are patentable under 35 U.S.C. §103 over the cited art. Thus, each of the presently pending claims in this application is believed to be in immediate condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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